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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,384	03/01/2002	Cherita Arnece Peppers	16356.686 (DC-03130)	3346
27683	7590	11/02/2005	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			ROMANO, JOHN J	
			ART UNIT	PAPER NUMBER
			2192	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/087,384

Applicant(s)

PEPPERS ET AL

Examiner

John J. Romano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 13-22 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 13-22 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/12/2005 has been entered.

Applicant's amendment and response received September 12th, 2005, responding to the July 13th, 2005, Office action provided in the rejections of claims 1-9, 13-22 and 26, wherein claims 1 and 14 have been amended. Claims 1-9, 13-22 and 26, remain pending in the application and which have been fully considered by the examiner.

### ***Prior Art's Arguments – Rejections***

2. Applicant's arguments filed September 12th, 2005, in particular on page 8-11, have been fully considered but they are not persuasive. For example,

(A) Applicant's arguments with respect to independent claims 1 and 14, (page 8 of the amendment and response), have been considered but are moot in view of the new ground(s) of rejection, necessitated by amendment.

(B) In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (page 10, second paragraph, of the amendment and response), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In this case, motivation was disclosed by **Dodson** (E.g., see Fig. 2 & Column 5, lines 4-25), wherein he teaches to inspect the current drivers, compare and replace them based on the hardware configuration. It would have been obvious to include a target directory as it would be required as part of the installation. Furthermore, **Dodson** teaches "...a user friendly technique...which facilitates the updating of software programs..." (Column 1, lines 46-49), wherein, preparing the target directory, which is a necessary step in updating drivers, facilitates the updating of the programs. Thus, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to comprise "...*the program preparing a directory for any new drivers needed for operation of the new operating system.*" and "...copying the new operating system to a directory structure..." wherein it is inherent that in order for the BIOS to be effectively upgraded as taught by Dodson, the BIOS must be copied to the appropriate location (directory structure). Therefore, there is suggestion and motivation to combine the prior

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art references from both the teachings of the prior art and the knowledge of persons of ordinary skill in the art.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims **1-8, 13- 21** and **26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Dodson, US 6,513,159 B1 (art of record and hereinafter **Dodson**), and further in view of Killebrew et al., US 5,577,244 (hereinafter **Killebrew**).

1. In regard to claim **1**, **Dodson** discloses:

- *"A method for an automated operating system upgrade in an information handling system, from an older version to a newer version, comprising: preparing a target information handling system for an upgrade using an upgrade preparation program..."* (E.g., see Fig. 9 & Column 6, lines 7-14) wherein, the MBU interface prepares the system for the upgrade of the BIOS (operating system).

- "...the program identifying the target system to determine whether a new operating system supports the target system..." (E.g., see Fig. 7 & Column 5, lines 44-55) wherein, the platform (target system) is determined and compared to validate the BIOS upgrade or to determine whether it supports the target system.
- "...the program determining an operating system manufacturer and version..." (E.g., see Fig. 9 & Column 6, lines 15-30) wherein a verified BIOS version is compared authenticated via a key infrastructure which is the equivalent of Applicant's operating system manufacturer.
- "...the program downloading the new operating system if required..." (E.g., see Fig. 8 (810) & Column 5, lines 59-61) wherein the BIOS is downloaded.
- "...copying the new operating system to a directory structure..." (E.g., see Fig. 8 (810) & Column 5, lines 59-61) wherein it is inherent that in order for the BIOS to be effectively upgraded the BIOS must be copied to the appropriate location (directory structure), wherein it is inherent that a directory structure is provided.
- "...the program scanning for all drivers on the target system ..." (E.g., see Fig. 2 (215) & Column 3, lines 2-8) wherein the drivers are identified (scanned) on the target system.
- "...the program downloading any additional required drivers to the new directory structure if needed to support the new operating system..."

(E.g., see Fig. 2 (205) & Column 3, line 66 – Column 4, line 7) wherein Master installer (the program) downloads any required drivers, which inherently are downloaded to the appropriate location or directory structure to be effective. Moreover, it is inherent that a driver, or a programming routine that links the operating system to a device, supports the operating system.

- *“...the program scanning to identify any factory installed software that are incompatible with the new operating system.”* (E.g., see Fig. 2 (230) & Column 3, lines 21-23) wherein the package selector identifies any drivers (factory installed software) that need to be upgraded or are incompatible with the new operating system.

But **Dodson** does not expressly disclose “...copying the new operating system to a directory structure...” or “...the program downloading any additional required drivers to the new directory structure if needed to support the new operating system....”.

However **Killebrew** discloses:

- - *“...the program preparing a directory for any new drivers needed for operation of the new operating system.”* (E.g., see Fig. 4 & Column 12, lines 18-24), wherein, a target director is created (prepared) for the new drivers needed for operation of the new operating system.

**Dodson** and **Killebrew** are analogous art because they are both concerned with the same field of endeavor, namely, an automated method for preparing to upgrade software. Therefore, at the time the invention was made, it would have been obvious to

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a person of ordinary skill in the art to combine **Killebrews'** target directory with **Dodsons'** upgrade preparation process. The motivation was disclosed by **Dodson** (E.g., see Fig. 2 & Column 5, lines 4-25), wherein he teaches to inspect the current drivers, compare and replace them based on the hardware configuration. It would have been obvious to include a target director as it would be required as part of the installation. Furthermore, **Dodson** teaches "...a user friendly technique... which facilitates the updating of software programs..." (Column 1, lines 46-49), wherein, preparing the target directory, which is a necessary step in updating drivers, facilitates the updating of the programs. Thus, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to "*...the program preparing a directory for any new drivers needed for operation of the new operating system.*".

3. In regard to claim **2**, the rejections of base claim **1** are incorporated.

Furthermore, **Dodson** discloses:

- "...in response... the program prompting the target system for an approval to uninstall the incompatible software." (E.g., see Fig. 4 & Column 4, lines 13-23), wherein, the program prompts the user on the target system for approval to install the driver upgrade or uninstall the incompatible software.

4. In regard to claim **3**, the rejections of base claim **2** are incorporated.

Furthermore, **Dodson** discloses::

- "...in response to the approval, the program automatically uninstalling the incompatible software." (E.g., see Fig. 4 & Column 4, lines 22-23),



wherein installing upgraded drivers may include uninstalling the incompatible driver when necessary.

5. In regard to claim 4, the rejections of base claim 2 are incorporated.

Furthermore, **Dodson** discloses:

- "...in response to a denial of the approval, the program advancing to a next step without uninstalling the incompatible software." (E.g., see Fig. 4 & Column 4, lines 13-23), wherein, the program advances to a next step without uninstalling the software if not approved.

6. In regard to claim 5, the rejections of base claim 1 are incorporated.

Furthermore, **Dodson** discloses:

- "...the program comparing data received from the target system against a table." (E.g., see Fig. 2 & Column 3, lines 36-49), wherein, the known hardware of the system is compared with valid stacks, which is the equivalent of a table.

7. In regard to claim 6, the rejections of base claim 5 are incorporated.

Furthermore, **Dodson** discloses:

- "...the table containing compatible results obtained from independent testing." (E.g., see Fig. 2 & Column 3, lines 36-49), wherein, the stacks are known to be valid wherein it is inherent that independent testing was performed in order to validate the stack.

8. In regard to claim 7, the rejections of base claim 6 are incorporated.

Furthermore, **Dodson** discloses:

- *“...the program using results of the comparing to determine which applications and drivers of the target system are compatible with the new operating system.”* (E.g., see Fig. 2& Column 3, lines 44-49), wherein, the package selector (230) selects the drivers that need to be installed or updated on the computer system, the drivers are compared against the valid stacks (table) and the drivers that should be installed are determined from that stack as a result of the comparing.

9. In regard to claim **8**, the rejections of base claim **6** are incorporated.

Furthermore, **Dodson** discloses:

- “...the program initiating removal of incompatible software.”* (E.g., see Fig. 4 & Column 4, lines 13-23), wherein, the program initiates the installation of an upgrade and thus the removal of incompatible software.

10. In regard to claim **13**, the rejections of base claim **1** are incorporated.

Furthermore, **Dodson** discloses:

- *“...displaying upon a display device any current hardware information.”* (E.g., see Fig. 4 & Column 4, lines 13-17), wherein the results of the hardware are displayed to the user.

11. As per claims **14-21** and **26**, this is a computer program product version of the claimed method discussed above, in claims **1**, **5-7** and **13**, wherein all claimed limitations have also been addressed and/or cited as set forth above, wherein **Dodson**

also discloses a computer readable storage medium storing "computer readable program code" (E.g. see, Figure 1 (145) & Column 2, lines 51-53).

12. Claims **9** and **22** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dodson**, in view of **Killebrew** and further in view of Kenyon et al., US 2002/0100035 (hereinafter **Kenyon**).

13. In regard to claim **9**, the rejections of base claim **1** are incorporated. But **Dodson** does not expressly disclose "...*driver include at least one of an audio driver, video driver, modem driver, and network driver.*". However **Kenyon** discloses:

- "...*driver include at least one of an audio driver, video driver, modem driver, and network driver.*" (E.g., see Figure 1a & Page 4, Paragraph [0044]), wherein audio, video and network drivers are upgraded.

The combined art of **Dodson and Killebrew** (hereinafter **the combined art**) and **Kenyan** are analogous art because they are both concerned with the same field of endeavor, namely, an automated method for preparing to upgrade software. Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine **Kenyans'** specific drivers with **the combined arts'** upgrade preparation process. The motivation was disclosed by **Dodson** (E.g., see Fig. 2 & Column 5, lines 4-25), wherein he teaches to inspect the current drivers, compare and replace them based on the hardware configuration. It would have been obvious to include a modem and network driver as Dodson's invention is performed on a distributed network and would thus require such drivers. Furthermore, **Dodson** teaches

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"...to locate all installed hardware peripherals and drivers" (Column 3, lines 6-8), wherein any audio, video, network and modem drivers would be located and thus upgraded. Thus, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include at least one of audio, video, modem or network driver in the driver upgrade.

14. As per claim **22**, this is a computer program product version of the claimed method discussed above, in claim **9**, wherein all claimed limitations have also been addressed and/or cited as set forth above, wherein **Dodson** also discloses a computer readable storage medium storing "computer readable program code" (E.g. see, Figure 1 (145) & Column 2, lines 51-53).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Romano whose telephone number is (571) 272-3872. The examiner can normally be reached on 8-5:30, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JJR

A handwritten signature in black ink, reading "Anthony Nguyen-Ba". The signature is fluid and cursive, with the first name "Anthony" being more prominent than the last name "Nguyen-Ba".

ANTONY NGUYEN-BA  
PRIMARY EXAMINER